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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,877	12/11/2001	Matthew L. Albert	600-1-291 CON	4555

23565 7590 12/17/2003

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EXAMINER

NICKOL, GARY B.

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 12/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/014,877

Applicant(s)

ALBERT ET AL.

Examiner

Gary B. Nickol Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-48 are pending.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 17-21 drawn to an *in-vitro* method of delivering antigen to dendritic cells comprising contacting dendritic cells with apoptotic cells, classified in class 435, subclass 4.
- II. Claims 1-16, 18-21, drawn to a method of delivering antigen to dendritic cells comprising contacting dendritic cells with apoptotic cells *in-vivo*, classified in class 424, subclass 93.1.
- III. Claims 22-23, drawn to a method of generating antigen-specific cytotoxic T lymphocytes comprising contacting T lymphocytes with dendritic cells that have been exposed to apoptotic cells expressing an antigen, classified in class 435, subclass 4.
- IV. Claim 24, as solely drawn to a method of administering antigen-specific cytotoxic T-cells to an individual with a disease, classified in class 424, subclass 93.71.

- V. Claims 25, 43-45 as solely drawn to a method of administering apoptotic-primed dendritic cells to an individual with a disease for the purpose of activating T-cells, classified in class 424, subclass 93.71.
- VI. Claims 26, 35-42, drawn to an antigen presenting dendritic cell and pharmaceutical compositions thereof, classified in class 435, subclass 372.
- VII. Claim 27, drawn to cytotoxic T lymphocytes, classified in class 435, subclass 372.3.
- VIII. Claims 28-30, drawn to a method of assessing CTL activity comprising exposing antigen presenting dendritic cells to a population of T cells to be assayed for their ability to exhibit killer cell activity, classified in class 435, subclass 4.
- IX. Claims 31-34, drawn to a method of delivering antigen to dendritic cells comprising contacting dendritic cells with material selected from the group consisting of a reconstituted apoptotic cell system, apoptotic cell fragments, and liposomes comprising at least one antigen and a material which enhances internalization and translocation of antigen to an antigen processing compartment of said dendritic cells, classified in class 435, subclass 4.

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- X. Claims 46-47, drawn to a method of activating CD4+ T cells comprising contacting a population of T lymphocytes with dendritic cells which have been contacted with antigen present on necrotic cells, classified in class 435, subclass 4.
- XI. Claim 48, drawn to a method of activating CD4+ and CD8+ T cells against tumor cells comprising a tumor antigen, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

The Inventions of Groups VI and VII represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects.

The inventions of Groups I-V and VIII-XI are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success. For example, Group I is limited to practicing the method in-vitro, while Group II is a separate invention since the method is practiced in-vivo. Groups IV and V are separate inventions that administer different products. Groups X and XI are independent and distinct since they require the activation of different cell types to practice the invention.

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The invention of Group VII and the method of Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the cytotoxic lymphocytes as claimed can be used in a materially different process such as methods of administering such lymphocytes to an individual with a disease.

The invention of Group VI and the method of Group I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the dendritic cells as claimed can be used in a materially different process such as methods of administering such cells to an individual with a disease.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

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Note:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143.

The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.  
Examiner  
Art Unit 1642

GBN  
December 15, 2003

A handwritten signature in black ink, appearing to read "Gary B. Nickol", is written over the typed name and date.